



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,771	04/30/2001	Gideon Fostick	Q63730	1088

7590 05/02/2003

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
WASHINGTON, DC 20037-3213

EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 05/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/843,771

Applicant(s)

FOSTICK, GIDEON

Examiner

Ming Chow

Art Unit

2645

2

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Objections***

1. The Specifications is objected to because it contains embedded hyperlinks and/or other forms of browser-executable code (see line 6-7 page 12 of the Specifications, and others). PTO policy does not permit the PTO patent documents to link to any live commercial Web sites. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. One suggestion is to spell out the word “www” as “world wide web” so that the referred web page will not be linked to a live web site.

***Claim Objections***

2. Claim 7(iv) is objected to because of the following informalities: “compatible message.a” should be read as “compatible message.”. Appropriate correction is required.

3. Claim 9 is objected to because of the following informalities: “vi. transmitting” should be read as “transmitting”. Appropriate correction is required. Also, “deviceby” should be read as “device by”. Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 5 recites the limitation "replying to the voice message" is confusing. It is unclear whether the reply is addressed to the "voice message" or the "converted voice message" (text format). On line 1-2 page 6 of the specification, it is obvious that the reply is addressed to the "converted voice message".

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 6, 7(iii) and 15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

Art Unit: 2645

invention. The phrase “transferring said converted message to said CAS” of claim 1 is not disclosed by the specification. On line 19-21 page 5 of the specification, the disclosure states that the converted message is transferred to a message receiver device (not the CAS as claimed).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Agraharam et al (US: 6483899).

Art Unit: 2645

Regarding claim 1, Agraharam et al teach on column 1 line 52-60 a voice-messaging system (claimed "CAS") converts voice message into a text message (claimed "non-voice format") by using the speech recognition software (claimed "AVRS").

Regarding claims 2 and 3, Agraharam et al teach on column 1 line 60-64 the text message is transmitted to the recipient as an electronic mail or a facsimile document. It is inherent there must be interfaces to e-mail and FAX, and the receiving communication devices must be e-mail and FAX enabled.

7. Claims 6, 7, 9, 12, 13, 14 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Skinner et al (US: 6529737). Skinner et al teach on column 2 line 47 to column 3 line 7 the originator sends a voice message that is converted by a voice recognition system into an SMS. Skinner et al teach on item 20 Fig. 1 "telecommunications switch" (claimed "CAS").

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2645

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Agraharam et al as applied to claim 1 above, and in view of Fortman (US: 6203192). Agraharam et al failed to teach "CAS is.....SMS message". However, Fortman teaches on column 6 line 67 to column 7 line 3 translating voice messages (item 1220 Fig. 1 POTS telephone) to SMS messages. It would have been obvious to one skilled at the time the invention was made to modify Agraharam et al to have the "CAS is.....SMS message" as taught by Fortman such that the modified system of Agraharam et al would be able to support the SMS to the system users.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Agraharam et al as applied to claim 1 above, and in view of Skinner et al (US: 6529737). Agraharam et al failed to teach "reply to the voice message". However, Skinner et al teach on column 2 line 62 to column 3 line 5-7 subscriber responds (claimed "reply") to the received message (SMS that is converted from the voice message) by placing a separate phone call. Agraharam et al teach converting a voice message left by a phone call to non-voice format and transfer the non-voice format to a subscriber. It would have been obvious to one skilled at the time the invention was made to modify Agraharam et al to have the "reply to the voice message" as taught by Skinner et al such that the modified system of Agraharam et al would be able to support the replying to the voice message to the system users.

10. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al, and in view of Casellini (US: 6404860). Skinner et al failed to teach "composing a

Art Unit: 2645

message.....by speech". However, Casellini teaches on column 1 line 62-64 responding with a pre-recorded message.

It would have been obvious to one skilled at the time the invention was made to modify Skinner et al to have the "composing a message.....by speech" as taught by Casellini such that the modified system of Skinner et al would be able to support the choosing a pre-recorded message to the system users.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al and Casellini as stated in claim 10 above, and in view of Groner (US: 6507643). Skinner et al and Casellini failed to teach "preparing of.....by said CGP". However, Groner teaches on Fig. 11D prompting the caller to state a time (item 298), and to dictate their message (item 302). Groner also teaches on column 11 line 54-56 caller states name. The time, message, and name stated by the caller (reads on claimed "chosen by said CGP") are the claimed "additional part of said composed message". Groner also teaches on Fig. 7 message header structure ("TO:", "Subject:", etc.), and "(Tome Jones) can be reached at (408-555-1212, evenings)" are claimed "pre-recorded message". It would have been obvious to one skilled at the time the invention was made to modify Skinner et al and Casellini to have the "preparing of.....by said CGP" as taught by Groner such that the modified system of Skinner et al would be able to support the composed message to the system users.



Art Unit: 2645

***Conclusion***

12. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Baker et al (US-PAT-NO: 6,215,858) teaches automated short message attendant.

13. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to TC2600's Customer Service FAX Number 703-872-9314.**

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

